SUPREME COURT, U. S.

FILED

DEC 30 1970

E. ROBERT SEAVER, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1970.

No. 982.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Petitioner,

v.

NORTON COMPANY,
STUDEBAKER-PACKARD CORPORATION,
HAGCO CORPORATION,
Respondents.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.

REPLY OF MINNESOTA MINING AND MANUFACTURING COMPANY, PETITIONER, IN SUPPORT OF CERTIORARI.

THOMAS V. KOTHEKA,
WILLIAM S. BOSTON,
ARTER & HADDEN,
1144 Union Commerce Building,
Cleveland, Ohio 44115,

EDWARD A. HAIGHT,
HAIGHT, HOWLEY & DAVIS,
2020 Board of Trade Building,
Chicago, Illinois 60604,

HAROLD J. KINNEY,
STANLEY G. DELAHUNT,
KINNEY, ALEXANDER, SELL, STIELDT & DELAHUNT,
2101 Hudson Road,
St. Paul, Minnesota 55101,
Counsel for Petitioner.

December 30, 1970.

THE GAYER LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-0347

In the Supreme Court of the United States

OCTOBER TERM, 1970.

No. 888.

MINNESOTA MINING AND MANUFACTURING COMPANY,

Petitioner,

v.

NORTON COMPANY,
STUDEBAKER-PACKARD CORPORATION,
HADCO CORPORATION,

Respondents.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

REPLY OF MINNESOTA MINING AND MANUFACTURING COMPANY, PETITIONER, IN SUPPORT OF CERTIORARI.

Norton agrees (p. 2 of its brief) "it would be well for this Court to confirm to the lower Federal Courts that properly drawn patents for truly meritorious inventions will be sustained and upheld." It merely does not think Norton's case is the one in which to clarify standards of validity.

Norton admits (p. 2) there are "differences" between the prior art and the invention at issue, but considers them "minor." Therefore, although the 336-Hoover patent was found by both courts below to satisfy every other

requirement of the patent law (including the legal requirement that Hoover had not been anticipated by any of the prior art patents referred to by Norton), Norton argues the invention (p. 3) was "obvious."

Norton was of different view when it attempted "to secure a patent on any developments contained in its 'Bear-Tex' product—a copy of Minnesota's 'Scotch-Brite' products" 426 F.2d at 1122, Appendix page 10. At that time "Norton represented to the patent office and the public that 'Bear-Tex' [Norton's copy of Hoover] was a revolutionary product." 426 F.2d at 1122, Appendix page 10. It was, as Norton then viewed it, "*A completely new form of abrasive tool.*" (1293a, 1315a, 1330a.)

It is obvious, both from the decision below holding the Hoover invention "obvious," and from Norton's argument in hope to escape review, that the standards to determine whether an invention is "obvious" desperately need clarification.

The need is emphasized by the diversity of treatment of that question in cases coming from Courts of Appeals, and is exemplified in a striking way by this one. The critical question is whether courts that purport to apply the standards of *Graham v. John Deere* (1966), 383 U.S. 1, 17, may adjudge an invention "obvious" without mentioning, or ranking findings on, *Graham's* critical test concerning the "level of ordinary skill in the pertinent art."

Here, neither court undertook to discuss, or say anything at all on, this point.

Without a determination of the "level of ordinary skill in the pertinent art," one cannot possibly determine—unless new standards are to be created—whether a given invention is or is not "obvious."

It thus is idle for Norton to pretend (p. 2) that the questions presented do not arise in this case.

The critical nature of the questions is illuminated by the circumstance that the Hoover invention proved to be beyond the reach of even the highly skilled, let alone the statutory "ordinary," workman. Observe that Norton—the biggest manufacturer of abrasive devices in the world—does not deny that, after it obtained samples of the 3M product, it took *Norton* 13 *months to produce its* "*copy of Minnesota's 'Scotch-Brite' products.*" 426 F.2d at 1122, Appendix page 10. Norton's explanation is that (p. 12) such "long efforts" to produce what—according to Norton—was all the time "obvious," were required in order to discover suitable material, determine proper proportions, and develop equipment, all to be part of the disclosure of the then as yet unissued Hoover patent.

Norton does not explain why, after it had samples of the Hoover article in hand—and therefore knew that the product could be produced—it found it necessary to put to work, to unravel the secret it now calls "obvious," a team of research men, namely:

G. W. Wells,
M. F. Raether,
J. L. Mueller,
C. G. Baldwin,
M. T. Gladstone,
G. L. Haywood,
E. J. Keyes,
Raymond R. Lucey,
Mr. Pulensky,
J. R. Quinan, and
W. D. White.

Norton does not explain *why*—if the whole thing was obvious—these skilled researchers required 371 pages in 17 laboratory research notebooks and 75 memoranda to record their findings. (1459a-1468a, 1277a-1289a, 1132a-1133a.) After all, these matters are disclosed *by a mere 11 pages* of the patent.

These 371 laboratory notebook pages and 75 memoranda, along with Norton's efforts and those of Fiber Bond (owner of one of the patents Norton says makes Hoover "obvious") to reproduce Hoover, make up the "page of history" that, as Mr. Justice Holmes remarked, "is worth a volume of logic." *New York Trust Co. v. Eisner* (1921), 256 U.S. 345, 349.

Ignoring the trial court's findings, Norton relies instead (pp. 3-10) on inferences and conclusions from the District Court's opinion that conflict with Norton's own experience and that of Fiber Bond. An example is the pretense that the Maisel patent utilized "essentially" the same web as Hoover, and therefore made Hoover "obvious." Maisel is so important to Norton that Norton *refers to it 9 times* in the 13 pages of its brief. But Norton *ignores altogether* that the owner of Maisel, Fiber Bond, *was unable to reproduce the Hoover article* even though it had in hand *both* the Maisel patent *and* samples of the Hoover product. It succeeded only *after* the Hoover patent issued.

What Norton pretends was "obvious," was not so to Fiber Bond—or to the skilled researchers in Norton's laboratories.

So desperate is Norton's wish to escape review that it now even denies (p. 8) the "commercial success" achieved by the Hoover product. Norton is forgetful. After its researchers finally unlocked the secret of Hoover, and

Norton marketed its copy, it had, the trial court found, "vast acceptance" and "commercial success," 280 F. Supp. at 693, Appendix page 54, as, of course, had the Hoover product which has found waiting markets throughout the world.

Norton is forgetful too (p. 4, Note 2) in asserting that 3M admitted at the trial that "the same pads without added abrasive" have equal utility and "enjoy the same commercial success." No such admission was made. Norton's assertion is supported by nothing in the record—least of all by the record reference Norton gives for its astonishing lapse of memory.

The embarrassment Norton finds in explaining *why* its skilled researchers did not find the secret of Hoover "obvious," is reflected in its need to denominate the patented article (p. 4) a "scrub rag." This is pure coinage of Norton. It diverts attention from the world-wide use this *abrasive* article (shown in the photograph opposite page 6 of the petition) has found in industrial metal finishing, polishing, and buffing operations. It also diverts attention from Norton's 13-months' study of Hoover by a team of researchers skilled in *abrasives* technology, aided by the sophisticated laboratories and test facilities of the world's biggest manufacturer of *abrasive* devices.

The questions the case presents need attention if the standard by which courts are to determine whether an invention is "obvious" is not to be left in disarray. The Court should see that the Constitutional mandate "To promote the Progress of * * * useful Arts" is carried out.

CONCLUSION.

The writ should issue.

Respectfully submitted,

THOMAS V. KOVICKA,
WILLIAM S. BURTON,
AKTER & HARDEN,
1144 Union Commerce Building,
Cleveland, Ohio 44115,

EDWARD A. HAIGHT,
HAIGHT, HOFFELDT & DAVIS,
2820 Board of Trade Building,
Chicago, Illinois 60604,

HAROLD J. KINNEY,
STANLEY G. DELAHUNT,
KINNEY, ALEXANDER, SELL, STELDT & DELAHUNT,
2501 Hudson Road,
St. Paul, Minnesota 55101,

Attorneys for Petitioner,
Minnesota Mining and
Manufacturing Company.

December 30, 1970.